

REMARKS

This communication responds to the Office Action mailed on December 14, 2005, and the references cited therewith. Claims 1-3, 5, 7-9, 13-14, and 16-17 are amended, no claims are canceled, and claim 20 is added. As a result, claims 1-20 are now pending in this Application.

It is respectfully noted that the Title of the Application has been amended to be more concise, and not due to any concern expressed by the Office. Similarly, claims 1-3, 5, 7-9, 13-14, and 16-17 have been amended to correct typographical errors and eliminate superfluous language, and not for reasons related to patentability.

Objection to the Specification

The Office has brought the recommended language style for the Abstract of the Disclosure to the Applicant's attention. The Applicant appreciates the Examiner's thorough review in this regard, and the Abstract has been amended in accordance with the suggestions offered. It is believed that this amendment of the Abstract fully addresses the concerns expressed by the Office.

§112 Rejection of the Claims

Claims 14-19 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness and for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office noted that "it is not clear to the examiner whether it is the description of the RFID circuit or the RFID circuit [that has been] claimed."

In response, the Applicant respectfully notes that neither the description of the circuit, nor the circuit, is claimed. Rather, it is the "machine-readable medium" storing a description of an RFID circuit that is claimed. As noted in the Application:

"... embodiments of the present invention may be implemented and not only as a physical circuit or module (e.g., on a semiconductor chip) but, also within a machine-readable media. For example, the circuits and designs described above may be stored upon, or embedded within, a machine-readable media associated with a design tool used for designing semiconductor devices. Examples include a netlist formatted in the VHSIC Hardware Description Language (VHDL), the Verilog language, or the SPICE language. ... a machine readable-readable

medium may comprise a read-only memory (ROM), a random access memory (RAM), magnetic disc storage media, optical storage media, flash memory devices, electrical, optical, acoustic, or other form of propagated signal (e.g., a carrier wave, infrared signal, radio-frequency signal, a digital signal, etc.).”
Application, paragraph [0093].

The Applicant believes that one of skill in the art would have no difficulty in determining the subject matter which the Applicant regards as the invention, and thus the Applicant declines to amend claims 14-19 at this time. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of claims 14-19 under 35 USC § 112, second paragraph.

§103 Rejection of the Claims

Claims 1-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Applicant’s Admitted Prior Art (hereinafter “AAPA”) in view of Roesner et al. (U.S. 5,583,819; hereinafter “Roesner”). First, the Applicant does not admit that Roesner is prior art and reserves the right to swear behind this reference in the future. Second, since a *prima facie* case of obviousness has not been established as required by M.P.E.P. § 2142, the Applicant respectfully traverses these rejections.

The Examiner has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). In combining prior art references to construct a *prima facie* case, the Examiner must show some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teaching of the references. *Id.* The M.P.E.P. contains explicit direction to the Examiner that agrees with the *In re Fine* court:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant’s disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d (BNA) 1443 (Fed. Cir. 1992). However, while it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 U.S.P.Q.2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979)). However, the level of skill is not that of the person who is an innovator but rather that of the person who follows the conventional wisdom in the art. *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 474, 227 U.S.P.Q. 293, 298 (Fed. Cir. 1985). The requirement of a suggestion or motivation to combine references in a *prima facie* case of obviousness is emphasized in the Federal Circuit opinion, *In re Sang Su Lee*, 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002), which notes that the motivation must be supported by evidence in the record.

No proper *prima facie* case of obviousness has been established because combining the references does not teach all of the limitations set forth in the claims, there is no motivation to combine the references, and combining the references provides no reasonable expectation of success. Each of these points will be explained in detail, as follows.

Combining The References Does Not Teach All Claim Limitations.

First, with respect to independent claims 1, 7, and 13, as admitted by the Office, the AAPA is “silent on teaching the calibration value is stored in a non-volatile memory.” Further, with respect to claims 2-6 and 8-12, the AAPA “is silent on teaching comparing the recovered clock signal to an oscillator clock signal and storing a value based on the comparison between the recovered clock and oscillator clock.” It is respectfully noted that, in addition, a “first oscillator” and a “second oscillator” included in the RFID circuit are also not disclosed by the AAPA, as claimed by the Applicant (in amended independent claims 1, 7, 13-14, and in new independent claim 20). Roesner also fails in this regard.

The AAPA illustrates a single oscillator 46 in FIGs. 4 and 5. No first and second oscillators are shown, described, or suggested. Roesner also teaches the use of a single oscillator

34 in an RFID tag that “operates at approximately at the carrier frequency o the input signal or some multiple thereof.” Roesner, Col. 11, lines 5-6. All timing in the applications disclosed by Roesner make use of this single oscillator in an RFID tag. *See* Roesner, Col. 11, line 42 – Col. 12, line 27.

Thus, since only a single oscillator is taught by both AAPA and Roesner, no combination of Roesner and the AAPA can provide the missing elements claimed by the Applicant in independent claims 1, 7, 13-14, and 20, and a *prima facie* case of obviousness has not been established. Further, it is respectfully noted that if an independent claim is nonobvious under 35 USC § 103, then any claim depending therefrom is also nonobvious. *See* M.P.E.P. § 2143.03. Therefore, claims 2-6, 8-12, and 15-19 are also nonobvious.

There is No Motivation to Combine The References.

As noted immediately above, the AAPA and Roesner each teach the use of a single oscillator. Thus, both the AAPA and Roesner teach away from the use of two oscillators. The test for obviousness under ' 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985). References must be considered in their entirety, including parts that teach away from the claims. *See* MPEP § 2141.02. The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Therefore, neither the AAPA nor Roesner provide motivation for the suggested combination.

Combining the References Provides No Reasonable Expectation of Success.

Modifying the AAPA with the non-volatile memory of Roesner would not lead one of ordinary skill to a reasonable expectation of success. This is because any combination of the AAPA and Roesner must necessarily include only one oscillator. Therefore, the suggested combination does not provide a reasonable expectation that a circuit including two oscillators would result, and all of the pending claims are nonobvious.

In summary, none of the references disclose an apparatus having “a first oscillator” and “a second oscillator” in the RFID circuit, as claimed by the Applicant. There is no motivation to combine the references (in fact, the AAPA and Roesner both teach away from the suggested modification), and no reasonable expectation of success results from their combination. The requirements of *M.P.E.P.* § 2142 have not been satisfied, and a *prima facie* case of obviousness has not been established. It is therefore respectfully requested that the rejections to claims 1-13 under 35 U.S.C. § 103 be reconsidered and withdrawn.

CONCLUSION

The Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney, Mark V. Muller at 210-308-5677 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

CHRISTOPHER J. DIORIO ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
210 308-5677

Date March 13, 2006

By Mark V. Muller
Mark V. Muller
Reg. No. 37,509

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 13 day of March, 2006.

Dawn R. Shaw

Name

Dawn R. Shaw

Signature